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09/803,928	03/13/2001	Justin Charles Moodie	11266/102	9072

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 11/01/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,928

Applicant(s)

MOODIE ET AL.

Examiner

Etienne P LeRoux

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims Status

Claims 1-26 are cancelled. Claims 27-38 are pending. Claims 27-38 are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 27-29, 31, 33, 34, 35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,101,483 issued to Petrovich et al (hereafter Petrovich).

Claims 27 and 33:

Petrovich discloses a method of indicating whether items on a shopping list are located in the vicinity of a shopper [audible communication using speaker 88 of portable terminal 40, col 10, lines 39-62], the method comprising:

storing a shopping list in a portable computer device [memory 46, Fig 3B, col 4, lines 50-65], wherein the shopping list comprises a plurality of items:

receiving a signal at the portable computer device from a short-range, local wireless communications system located in a store [wireless access point 18, Fig 1, col 4, lines 1-12, col 5, lines 9-22];

Art Unit: 2161

determining from the received signal at the portable computer device whether any item on the shopping list is available in the store, if any of the items on the shopping list are determined to be available in the store, providing an indication to a user of the portable computer device that the item is available in the store [optimized shopping list directs a shopper 58 along a path 104 through shelves 102 of the shopping establishment 14, col 10, lines 25-38, Fig 4].

Claims 28 and 34:

Petrovich discloses wherein the short-range, local wireless communication signal is sent from a location in the store that is within the vicinity of the portable computer device, and wherein the indication provided to a user indicates that the item is within the vicinity of the user [col 10, lines 39-62, Fig 4].

Claims 29 and 35:

Petrovich discloses wherein the portable computer device is a personal digital assistant [col 6, lines 37-53].

Claims 31 and 37:

Petrovich discloses wherein the step of storing a shopping list in the portable computer device comprises downloading the shopping list from the Internet at a location inside of the store [col 4, lines 1-12].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2161

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of US Pat No 6,738,053 issued to Borgstrom et al (hereafter Borgstrom).

Claims 30 and 36:

Petrovich discloses the elements of claim 27 as noted above.

Furthermore, Petrovich discloses a short-range local wireless communications system [col 10, lines 10-62] but is silent regarding the Bluetooth communications standard. Borgstrom discloses the Bluetooth communications standard [Fig 11, 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Petrovich to include the Bluetooth communications standard as taught by Borgstrom for the purpose of providing a means of wirelessly connecting the PDA to the host computer in the shopping establishment. The ordinarily skilled artisan would have been motivated to improve the invention of Petrovich per the above for the purpose of providing a wireless portable device such that the shopper with his/her PDA can move between the shelves of the shopping establishment and select grocery items which are on a shopping list.

Claims 32 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrovich in view of US Pat No 6,640,214 issued to Nambudiri et al (hereafter Nambudiri).

Claims 32 and 38:

Art Unit: 2161

Petrovich discloses the elements of claim 27 as noted above.

Petrovich fails to disclose wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device. Nambudiri discloses wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device [col 12, lines 35-52]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Petrovich to include wherein the step of entering a shopping list in the portable computer device comprises receiving a selection of a recipe from a user; determining a list of items based on the ingredients specified in the recipe, and storing the list of items on the portable computer device as taught by Nambudiri for the purpose of providing an electronic means of purchasing the items from a shopping establishment which is geared to automated purchasing. The ordinarily skilled artisan would have been motivated to improve the invention of Petrovich per the above such that the shopper does not have to produce a hand written list of the ingredients which is subject to user error.

Response to Arguments

Applicant's arguments filed 8/5/2004 have been fully considered but they are not persuasive.

Art Unit: 2161

Applicant states on page 5, "Although Applicants do not necessarily agree with these rejections, and in order to further prosecution of this application, this response cancels claims 1-26 without prejudice to prosecute these claims in a continuation application. This response also adds new claims 27-38. Applicants submit that these claims are patentable over the art of record and thus are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass this case to issue at the Examiner's earliest convenience."

Examiner is not persuaded. Applicant states on page 5 that the prior art of record did not teach the limitations of cancelled claims 1-26 nor does the prior art of record teach the limitations of new claims 27-38. Examiner is perplexed as the limitations of claims 1-26 were element by element, clearly matched to the cited prior art. Once again for new claims 27-38 the limitations of claims 27-38 are element by element, clearly matched to prior art. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964). Examiner notes that Applicant has failed to distinctly and specifically point out errors in the examiner's action(s). Applicant provides no evidence of patentability of claims 27-38 and merely states that the claims are patentable over the prior art of record. Examiner is not persuaded. All limitations of new claims have been clearly matched to previously cited prior art and to new prior art rejection(s) necessitated by Applicant's introduction of new claims.

Art Unit: 2161

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Art Unit: 2161

Patent related correspondence can be forwarded via the following FAX number

(703) 872-9306

Etienne LeRoux

10/27/2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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